

**B. Amended claims 11 and 15 and the basis for their amendments:**

(1) Claim 11: This claim has been amended to recite that the circular disk is formed by pouring the high-boiled composition onto a circular platen. Basis is found in Example 1 appearing on pages 6 and 7 of the specification.

(2) Claim 15: This claim has been amended to recite that rigid disk has a thickness of between about one and about five millimeters. Basis is found in original claim 17, now canceled.

**C. New claims 18-21 and their basis:**

(1) New claim 18 is dependent from claim 11 and recites that the disk is formed by pouring the high-boiled composition onto a circular platen having a waffle pattern. Basis for this claim is found in Example 1 appearing at pages 6 and 7 of the specification.

(2) New claims 19-20 are product by process claims, claiming the product produced by the processes of claims 11 and 13, respectively.

(3) New claim 21 is dependent from claim 15 and recites that the disk has a waffle pattern. Basis for this claim is found in Example 1 appearing at pages 6 and 7 of the specification.

**D. Rejections under 35 U.S.C. 103(a):**

(1) Claim 11: This claim has been rejected under 35 U.S.C. 103(a) as being unpatentable over the following basic combinations of references:

(a) Kennedy (2,200,956) in view of Moore (1,652,789), further in view of Wilton Book of Candy and Candy, or

(b) Wilton Book of Candy in view of Moore and Candy, further in view of Kennedy, or

(c) Moore in view of Kennedy, further in view of Candy and Wilton Book of Candy

with the basic combinations(a), (b) or( c) being augmented further in view of Ito (5,284,672) and Benaud (1,015,400).

Claim 11 is directed to a process of forming an edible ice cream cone by preparing a high-boiled composition, forming the composition into a waffled circular disk by pouring the composition onto a circular platen, removing the disk from the platen, and while the disk is still pliable wrapping it around a conical mandrel to form a cone.

Kennedy describes a process of forming a chocolate ice cream cone by forming a chocolate sector (FIGS. 3 and 4) and folding it into a cone.

Moore describes an ice cram holder made of candy but doesn't describe how the holder is made.

Wilton Book of Candy describes making a candy dish by making a circle of cooked candy syrup and placing it into a bowl to mold its shape.

Candy was cited for its description of various candy recipes.

Ito and Benaud describe forming an ice cream cone by wrapping a circular cooked dough product around a cone former.

There are three alternative rejections, each involving a total of six references. Although it could be argued the citation of such a large number of references should itself weigh against a holding of obviousness, the real test is whether there is any suggestion or motivation in the prior art to make the selection of references made by the Examiner.

“Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” *In re Bond*, 15 USPQ2d 1556, 1558 (Fed. Cir. 1990).

“It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template an selecting elements from references to fill the gaps. *Interconnect Planning*, 774 F. 2d at 1143, 227 USPQ at 551. The references themselves must provide some teaching whereby the applicant's combination would have been obvious.” *In re*

*Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

It is submitted that there is no reason suggested by any or all of these references themselves as to why they should be combined. Clearly they are being combined in a hindsight manner solely in view of applicant's claimed invention.

None of Kennedy, Moore, Wilton Book of Candy, Candy or Benaud show forming a high boiled composition into at least one circular disk "by pouring said high-boiled composition onto a circular platen". Ito shows placing kneaded dough 2A onto a circular heating plate 10, sandwiching the dough between heating plate 10 and another heating plate (FIG. 2) and cooked into a molded sheet 5, 6. The molded sheet 5,6 is not pliable as shown by a subsequent heating step to soften the sheet (column 4, lines 41-45). Thus, there is no suggestion in Ito of wrapping his sheet 5 around a conical mandrel to form a cone "while said circular disk is still pliable". To suggest that another reference would supply this deficiency would do violence to the teaching of Ito that his molded sheet 6 is shipped to a user for softening and forming into a cone. It is requested that the rejection of claim 11 be withdrawn.

(2) Claim 13: This claim has been rejected under 35 U.S.C. 103(a) as being unpatentable over the following basic combinations of references:

(a) Kennedy (2,200,956) in view of Moore (1,652,789), further in view of Wilton Book of Candy and Candy, or

(b) Wilton Book of Candy in view of Moore and Candy, further in view of Kennedy, or

(c) Moore in view of Kennedy, further in view of Candy and Wilton Book of Candy

with the basic combinations(a), (b) or (c) being augmented further in view of Hoffman, Ogata, Sakuma and Morimoto, further in view of Wilton 1994 Year Book, Disney's Family Cook Book, Product Alert, HFD, Cincinnati Post and Oregonian.

It is again submitted that there is no reason suggested by any or all of these numerous references themselves as to why they should be combined. Clearly they are being combined in a

hindsight manner solely in view of applicant's claimed invention.

None of these references teach or suggest first forming a sheet or strand of a high-boiled composition, and then grinding or chopping the sheet or strand to form a powder or pellets. Clearly this rejection of claim 13 is improper and should be withdrawn.

(3) Claim 15: This claim has been rejected under 35 U.S.C. 103(a) as being unpatentable over the following basic combinations of references:

(a) Kennedy (2,200,956) in view of Moore (1,652,789), further in view of Wilton Book of Candy and Candy, or

(b) Wilton Book of Candy in view of Moore and Candy, further in view of Kennedy, or

(c) Moore in view of Kennedy, further in view of Candy and Wilton Book of Candy with the basic combinations(a), (b) or (c) being augmented further in view of Ito (5,284,672) and Benaud (1,015,400).

As argued above, there is no reason suggested by any or all of these references themselves as to why they should be combined. Clearly they are being combined in a hindsight manner solely in view of applicant's claimed invention.

None of the cited references describe a rigid disk of a high-boiled composition having a thickness of between about one and about five millimeters. This limitation appeared in original claim 17 and the Examiner appears to take the position that this would "have been an obvious function of the size of the edible ice cream cone desired". However, every limitation in a claim is important to provide a successful product, and that is true in the present instance. Applicant has found that the recited thickness range provides adequate strength characteristics without requiring excessive amounts of material. It is requested that the rejection of claim 15 be withdrawn.

E. Conclusion:

In view of the present amendments and for the reasons presented it is respectfully requested that the rejections applied to the originally filed claims be withdrawn, and the remaining claims

allowed.

An early Notice of Allowability is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'R. Howard', written over a horizontal line.

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## ATTACHMENT A

### Complete Listing of All Claims

Claims 1-10 (canceled)

Claim 11 (currently amended): The process of forming an edible ice cream cone having a composition that is a transparent and/or translucent edible glass, comprising:

preparing a high-boiled composition selected from the group consisting of sucrose and glucose syrup, maltitol syrup, isomalt, and a modified isomalt;

forming the high-boiled composition into at least one circular disk by pouring said high-boiled composition onto a circular platen;

removing said circular disk from said platen; and

while said circular disk is still pliable wrapping said circular disk around a conical mandrel to form a cone.

Claim 12 (canceled)

Claim 13 (original): The process of forming an edible ice cream cone having a composition that is a transparent and/or translucent edible glass, comprising:

forming a high-boiled, extrudable composition selected from the group consisting of sucrose and glucose syrup, maltitol syrup, isomalt, and a modified isomalt in an extruder;

passing the high-boiled, extrudable composition through a die to form a sheet or strand;

grinding or chopping said sheet or strand to form a powder or pellets;  
feeding said powder or pellets to an injection molding extruder;  
processing the powder or pellets in said extruder at a temperature that forms an  
extrudable mass; and  
injecting the extrudable mass into a mold to form at least one ice cream cone.

Claim 14 (canceled)

Claim 15 (currently amended): A transparent and/or translucent edible ice cream cone precursor comprising a rigid disk of a high-boiled composition selected from the group consisting of sucrose and glucose syrup, maltitol syrup, isomalt, and a modified isomalt, said rigid disk having a thickness of between about one and about five millimeters.

Claim 16 (original): The ice cream cone precursor of claim 15 wherein said disk has a diameter of between about six and about twelve inches.

Claim 17 (canceled)

Claim 18 (new): The process of claim 11 wherein said disk is formed by pouring said high-boiled composition onto a circular platen having a waffle pattern.

Claim 19 (new): The ice cream cone product produced by the process of claim 11.

Claim 20 (new): The ice cream cone product produced by the process of claim 13.

Claim 21 (new): The ice cream cone product of claim 15 wherein said rigid disk has a waffle pattern.